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JUN 27 2000

Ivor R. Elrifi
Mintz, Levin, Cohn, Ferris, Glovsky, and Popeo, P.C.
One Financial Center
Boston, Massachusetts 02111

In re Application of
FARMER, et al
PCT Application No.: PCT/US98/11347
Int. Filing Date: 03 June 1998
Priority Date: 03 June 1997
Attorney's Docket No.: 19374-503
For: PROBIOTIC LACTIC ACID BACTERIUM
TO TREAT BACTERIAL INFECTIONS
ASSOCIATED WITH SIDS

DECISION ON
PETITION UNDER
37 CFR 1.47(a) AND
NOTICE OF REFUND

This is a decision on the "PETITION UNDER 37 C.F.R. §1.47(a)-(b)" filed 14 April 2000, which has been treated as a petition under 37 CFR 1.47(a) to accept the above-identified national stage application without the signature of co-inventor Robert J. Mikhail (Mikhail). The requisite \$130.00 petition fee has been submitted.

BACKGROUND

On 03 June 1998, applicants filed international application number PCT/US98/11347, which claimed priority to a prior United States application which was filed on 03 June 1997. A DEMAND for international preliminary examination, in which the United States of America (US) was elected, was timely filed on 04 January 1999. Accordingly, the thirty month period for paying the basic national fee in the US expired at midnight on 03 December 1999.

On 23 November 1999, applicant filed a transmittal letter for entry into the national stage in the US, which was accompanied by, inter alia, a check in the amount of \$1,720.00. The transmittal letter indicated that the \$1,720.00 check was intended to cover, inter alia, a basic national fee of \$930.00 and a surcharge of \$130.00 as required

by 37 CFR 1.492(e) for filing an oath or declaration later than 30 months from the earliest priority date. An oath or declaration as required by 35 USC 371(c)(4) was not filed.

On 24 March 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 USC 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration must be filed. The notification set a one month time limit in which to respond.

In order to satisfy the requirements of 35 USC 371(c)(4), applicant Sean Farmer (Farmer) filed, *inter alia*, on 14 April 2000 the following papers:

- 1) a transmittal letter;
- 2) a "PETITION UNDER 37 C.F.R. §1.47(a)-(b)" signed by Farmer, stating that Farmer made a diligent attempt to contact Mikhail via US mail and electronic mail, and giving Mikhail's last known address ;
- 3) the required \$130.00 petition fee under 37 CFR 1.17(i);
- 4) a declaration naming only Farmer as an inventor and signed only by Farmer.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(i), (2) factual proof that the nonsigning inventor refuses to execute the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the nonsigning joint inventor. Applicant has satisfied items (1) and (3) above.

With regard to item (2) above, section 409.13(d) **Proof of Unavailability or Refusal** of the Manual of Patent Examining Procedure (MPEP) states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

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The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached

should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

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Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made.

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Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature.

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When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

Farmer concludes in the "PETITION UNDER 37 C.F.R. §1.47(a)-(b)" that he has made a diligent attempt to contact Mikhail by US mail and by electronic mail. Yet, Farmer does not fully describe the exact facts which are relied on to establish that a diligent effort was made to find or reach Mikhail. Farmer does not include copies of documentary evidence such as a certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor, Mikhail, could not be found or reached. Further, Farmer has not demonstrated that a *bona fide* attempt was made to provide a copy of the application papers, including the specification, drawings, claims, and oath or declaration, to Mikhail for his signature.

With regard to item (4) above, section 409.03(a) **At Least One Joint Inventor Available** of the Manual of Patent Examining Procedure (MPEP) states, in part:

[A]n application deposited in the Patent and Trademark Office pursuant to 37 CFR 1.47(a) must meet the following requirements:

(A) All the available joint inventors must (1) make oath or declaration on their own behalf . . . and (2) make oath or declaration on behalf of the nonsigning joint inventor as required by 37 CFR 1.64. An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Further, 37 CFR 1.497 entitled **Oath or declaration under 35 USC 471(c)(4)** states, in part:

(a) When an applicant of an international application desires to enter the national stage under 35 USC 371 pursuant to §§ 1.494 or 1.495, he or she must file an oath or declaration that . . . (3) Identifies each inventor and the country of citizenship of each inventor; and

The declaration filed on 14 April 2000, does not identify each inventor and the country of citizenship of each inventor as required by 37 CFR 1.497(a)(3). Specifically, the declaration does not identify inventor Mikhail. Further, the declaration was not made on behalf of the nonsigning inventor, Mikhail.

Accordingly, since items (2) and (4) have not been satisfied, it is inappropriate to accord the national stage application status under 37 CFR 1.47(a) at this time.

Additionally, it is noted that 37 CFR 1.26 states, in part that any fee paid in excess of that required will be refunded. Further, the applicant incorrectly paid \$670.00 for the basic national fee on 23 November 1999. The applicant should have only paid \$96.00 for the basic national fee since the USPTO prepared the international examination report (IPER) which stated that the criteria of PCT Article 33(1) to (4) had been satisfied for all the claims presented in the application entering the national stage. See 37 CFR 1.492(a)(4). Accordingly, \$574.00 will be refunded to the applicant's deposit account.

DECISION

For the reasons discussed above, the petition filed under 37 CFR 1.47(a) is **DISMISSED**.

If reconsideration of the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

The excess \$574.00 paid for the basic national fee will be refunded in accordance with 37 CFR 1.26.

The application is being returned to the DO/EO/US for processing in accordance with this decision, that is, for (1) a refund of \$670.00 for the basic national fee (fee code 956) and (2) a charge of the correct basic national fee of \$96.00 (fee code 962) to applicant's deposit account 50-0311.



Diana L. Oleksa
Special Programs Examiner
PCT Special Programs Office



Conferee: Leonard E. Smith
PCT Legal Examiner
PCT Legal Office